

ATTENTION: PCT LEGAL OFFICE
Attorney Docket No. Q95051

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Josef OTT

Appln. No.: 10/580,344

Group Art Unit: 3673

Confirmation No.: 5820

Examiner: Leonard Smith

Filed: May 25, 2006

For: SEAL FOR EFFECTING A SEALING BETWEEN PARTS HAVING LIMITED
MOBILITY

RENEWED PETITION UNDER 37 CFR § 1.47 (b)

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Renewed Petition under 37 C.F.R. § 1.47(b) (the “Renewed Petition”), filed in response to a Decision on Petition mailed August 30, 2007 (the “Decision”) and dismissing with prejudice Petitioner’s original Petition Under 37 C.F.R. § 1.47(b), as filed on August 1, 2007 (the “Original Petition”). This Renewed Petition is being filed within the two month period for reply set in the Decision, as extended by two months on the basis of an accompanying Petition for Extension of Time and Fee in accordance with the USPTO communication of October 22, 2007, expressly providing that the period for reply in the Decision is extendable under 37 C.F.R. § 1.136(a).

Incorporation of Prior Submission

As a preliminary matter, Petitioner Weidmann Plastics Technology AG, the assignee of the present application and prior employer of the sole inventor, Josef OTT, who refuses to sign the Declaration for the present application, respectfully requests incorporation by reference of Petitioner’s Original Petition and accompanying exhibits. Where referenced in the present

Renewed Petition and in order to avoid duplication in the record, the exhibits from the Original Petition will be referred to herein by their original reference number, as “Original Petition Exhibit ____.” New Exhibits will be identified as “new Exhibit ____.”

Content of the Decision

The Decision identified at page 2 six requirements for a petition under 37 C.F.R. § 1.47(b), including (1) the fee under 37 C.F.R. § 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 C.F.R. § 1.147(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 C.F.R. § 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The Decision found that requirements (1), (3) and (6) are satisfied.

The Decision found that requirements (2), (4) and (5) are not satisfied. Petitioner is submitting evidence and documents that satisfy each of the three outstanding requirements, as subsequently detailed.

Requirement (2)

The Decision at page 2 acknowledges the Declaration of Mr. Stefan Day dated May 3, 2006 (**Original Petition Exhibit 14**) and the accompanying exhibits (**Original Petition Exhibit 2- Exhibit 8**) demonstrated that inventor Josef. Ott orally stated that he does not intend to execute the declaration. However, the Decision concluded that there is no evidence “that non-signing inventor Josef Ott was presented with a copy of the application papers (specification, claims, drawings, and oath or declaration).” The inventor must be shown to have understood “what exactly he is being asked to sign.” The Decision advised that there must be documentary evidence “such as a certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that a complete copy of the application papers had been sent to the applicant.”

Accompanying this Renewed Petition is a Declaration of Stefan Day dated December 6, 2007 (new **Exhibit 16**) and accompanying new **Exhibit B1** and new **Exhibit B2**) which details the activity of Mr. Day in further communicating with Mr. Ott and providing a clear indication of what Mr. Ott is being asked to sign. In particular, Mr. Day states in his Declaration that on October 8, 2007 he mailed to Mr. Ott (at Mr. Ott's home address: Sonnenrainstrasse 10, 8735 St Gallenkappel, Switzerland) a request to sign accompanying application papers for the above referenced application (USSN 10/580,344), including (1) the specification, drawings and claims, (2) the declaration and (3) the assignment documents. The request (new **Exhibit B1**) is a dual language document that clearly sets forth the background of the request and Mr. Ott's duty to sign the declaration and assignment. A request to return the signed documents by October 30, 2007 also was expressly made. The returned receipt, which is dated October 17, 2007 and evidences delivery to Mr. Ott on October 9., 2007 by virtue of Mr. Ott's signature, is provided as new **Exhibit B2**.

Mr. Day further states in his Declaration that he received a call from Mr. Ott on October 26, 2007 during which Mr. Ott stated that he would not sign and return the documents. Finally, Mr. Day states that he has not received the documents as of the date of his declaration, December 6, 2007.

On the basis of the foregoing evidence as embodied by new **Exhibit 16**, new **Exhibit B1** and new **Exhibit B2**, this requirement now is satisfied.

Requirement (4)

The Decision states with regard to requirement (4) that "the declaration has not been executed in accordance with 37 C.F.R. §§ 1.497(b)(1) and 1.47(b)." The Decision references MPEP §409.03(b)(A) for guidance as to who should sign on behalf of a corporation and the requirement to state the title of the person signing. The Decision finds that the name of the person signing is not clear and the title of the person signing is not stated.

Petitioner is providing a new Declaration that is signed and dated by Suzanne Thoma, Director, Weidmann Plastics Technology AG, on behalf of Weidmann Plastics Technology AG.

On the basis of the new Declaration, this requirement is satisfied.

Requirement (5)

The Decision acknowledged the Memorandum of Law provided by Mr. Stefan Day with regard to the provisions of Swiss Law that govern the rights of the Petitioner to the invention of Petitioner's prior employee, Josef Ott (**Original Petition Exhibit 15**). The Decision concludes that the **Original Exhibit 15** and related **Original Petition Exhibits 1-14** did not provide

“evidence as to the ‘employment and contractual duties’ of Mr. Josef Ott while employed by the 37 C.F.R. § 1.147 (b) applicant. Although, the employment agreements signed by Mr. Josef Ott (see Exhibits 11 and 12) indicate that he agreed to certain employment rules and regulations, the evidence does not indicate whether the invention was made as part of his ‘employment and contractual duties.’ It is noted that the declaration of Mr. Stefan A. Harke, Manager Laboratory and Measurement Engineering, appears to indicate that such “employment and contractual duties “ are shown in Exhibit 1. However, a translation into the English language of Exhibit 1 has not been provided. A full translation into the English language of all documents filed in a language different than the English language is required.”

In response, Petitioner is submitting herewith a Declaration of Martin Boppert, who currently holds the position Supervisor Standards, Patents and Information at Weidmann Plastics Technology AG (new **Exhibit 17**), and a Memorandum of Law by Stefan Day dated December 6, 2007 (new **Exhibit 18**) with accompanying new **Exhibit D1** and new **Exhibit D2**.

The Declaration of Mr. Boppert references and appends original documents related to the “employment and contractual duties” of Josef Ott at the time the invention was made, which Mr. Boppert found during a review of Petitioner's corporate files in preparation for this Renewed Petition. In particular, the Declaration of Mr. Boppert makes reference to an original declaration

of employment goals (new **Exhibit C1**) having two pages stapled together, a first being a “declaration of employment goals (identical to **Original Petition Exhibit 1**) and a second being a performance review. An English language translation of these two pages is provided as new new **Exhibit D1**. In addition, the Declaration of Mr. Boppart refers to a corporate form, which was in the PCT file related to the above referenced application, was prepared and signed by Mr. Ott’s supervisor, Frank Ehrig, and was dated June 22, 2004 (new **Exhibit C2**). The form refers to the filing by Petitioner of the initial application in Switzerland (SN 0201103), from which priority is claimed in the present application. The form clearly indicates proprietary interest by Weidmann Plastics Technology AG in the invention and applications that apply to protection of that invention. An English language translation of this document is provided as new **Exhibit D2**.

The Memorandum of Law by Mr. Day, which provides a basis in Swiss law for ownership by Weidmann Plastics Technology AG of the invention disclosed and claimed in the above referenced application, includes as exhibits the English language translations by Mr. Day of new **Exhibits C1 and C2** as new **Exhibits D1 and D2**.

The Declaration of Mr. Day (new **Exhibit 16**) further provides a copy of the original table of contents and pertinent Section 6.18 of the “Weidmann Rules for the Members of Management” (new **Exhibit B3**) which demonstrates the employment and contractual duties of Mr. Ott as a member of management during the period 2001-2004. An English language translation of the table of contents and Section 6.18 is provided in new **Exhibit B4**. Notably, the second full paragraph is particularly relevant and provides that “[a]ll rights, in particular copyrights and patent rights, rights in inventions not patent as well s all work results in software, which a member of the management team has developed alone or in corporation, are automatically within their creation transferred to the enterprise.

Conclusion

Based upon the present Renewed Petition, the previous Declaration of Mr. Stefan Harke, the foregoing Declarations of Mr. Martin Boppart and Mr. Stefan Day, and the Memorandum of Mr. Stefan Day, Petitioner respectfully submits that all of the six identified requirements for a grantable Petition under 37 C.F.R. § 1.47(b) have been satisfied.

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Weidmann Plastics Technology AG has demonstrated that it has a direct and substantial interest in protecting the invention that is disclosed and claimed in USSN 10/580,344, and that the acceptance of the accompanying Declaration, signed by Ms. Suzanne Thoma on behalf of Mr. Josef Ott and as representative of Weidmann Plastics Technology AG, is necessary to preserve the rights of Weidmann Plastics Technology AG in and to the invention disclosed and claimed in USSN 10/580,344 and any patent that may be issued from that application, and to prevent irreparable damage to Weidmann Plastics Technology AG should such rights be lost.

Petitioner notes that in the Decision at page 4, no additional petition fee is required. Petitioner understands that this does not relate to petitions for extension of time, and a petition for an additional two month extension of time, including payment of the related fee, accompanies this Renewed Petition.

The USPTO is directed and authorized to charge any additional statutory fee, to Deposit Account No. 19-4880. Please also credit any overpayments to this same Deposit Account.

Respectfully submitted,

/Alan J. Kasper/

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